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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|------------------------|------------------|
| 10/511,015 | 04/22/2005 | Bernhard Banowski | HM/5.22840/A/HEK 2/PCT | 8747 |

324 7590 11/22/2005

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EXAMINER

KIM, VICKIE Y

ART UNIT PAPER NUMBER

1618

DATE MAILED: 11/22/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/511,015

Applicant(s)

BANOWSKI ET AL.

Examiner

Vickie Kim

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 6-9 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 6-9 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. ____.
 - ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 1/7/05.
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date: ____.
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: ____.

DETAILED ACTION

Priority

1. Acknowledgment is made of applicant's claim for foreign priority under 35 U.S.C. 119(a)-(d).

Status of Application

1. Acknowledgement is made of preliminary amendment filed 10/8/2004. Upon entering the amendment, the claims 1-5 are canceled. New claims 6-9 are added.
2. The claims 6-9 are pending and presented for the examination.

Information Disclosure Statement(IDS)

The information disclosure statement (IDS) is submitted on 1/7/2005. The submission is in compliance with the provisions of 37 CFR 1.97. Accordingly, the information disclosure statement is being considered by the examiner. Please refer to applicants' copy of the 1449 submitted herewith.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 6, 8-9 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 6, 8-9 are utilizing a diphenyl ether substance having the general formula (I) as recited in claim 6. In line 3(claim 6), the substance is selected from hydroxydiphenyl ethers whereas the said substance is not necessarily hydroxydiphenyl

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ethers when the substitution of R1-R4 is not substituted by -hydroxy or R5 is substituted by Hydrogen(H). Thus, the scope of the claims are not clear and thus renders the claims indefinite. Dependent claims are properly included in this rejection.

Clarification is required.

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

6. Claims 6-7 are rejected under 35 U.S.C. 102(b) as being anticipated by Holzl et al(EP 1053989) or 102(e) by Holzl(US2003/0162836 or US2004/0186174).

Note: Since these EP patent and US application PUB. are essentially same, EP'989 would represent all the teaching included in US app. PUBs.

The claims are drawn to a method of reducing body odour by applying to skin a cosmetic deodorant comprising a diphenyl ether substance having general formula (I) – (III) as recited in instant claims 6-7.

Holzl et al(EP989, hereinafter) teaches a hydroxydiphenyl ether compounds as antimicrobially active substances in the preparation of deodorants or antiperspirants. An

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antimicrobial activity is against various organisms such as *S. aureus*, see abstract and page 39.

As to the instant claims, EP'989 teaches that hydroxydiphenyl ether compounds used is substantially same as the compounds required by instant claims, see compound having general structures of the formula (6) as recited in the paragraphs 4-9.

At paragraphs 75 and 78, the said active substance (i.e. hydroxydiphenyl ether compound having said formula) is used in the preparation of deodorants or antiperspirants.

At paragraph 66, EP'989 teaches that the said hydroxydiphenyl ether compounds is useful for deodorizing skin, hair or mucous membrane.

Since deodorants and antiperspirants, especially deodorants are already well known in the state of art that they are mainly made to reduce body odors, the claimed subject matter(i.e. a method of reducing body odor using deodorants comprising hydroxydiphenyl ether compounds as active substance) are well taught and all the claims are met. It is noted that arylsulfatase inhibition is considered to be inherent and naturally occurring when the application of said deodorants containing hydroxydiphenyl ether compound having said formula taught in the Holzl's Patent application.

7. Claims 8-9 are rejected under 35 U.S.C. 102(b/e) as being anticipated by, or alternatively obvious over Holzl et al((EP 1053989; US2003/0162836; or US2004/0186174) alone, or alternatively OTC products(secret™ or speedstick™).

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At paragraphs 78, EP'989 teaches how to make deodorants using the said active substances. EP'989 also teaches that personal care products are prepared customary methods based on individual's needs.

As to claims 8-9 that require gender specifically in respect of the amount and/or nature such as body odour formulations for men, the gender oriented deodorants or antiperspirants(e.g. Speed Stick® vs Lady Speed Stick®) are already well known in the fields and industries and because of the difference in amount of sweats and personal activities where the men commonly require higher protection. For example, the OTC(over-the -count) deodorants or antiperspirants are available in gender based products, and thus one would have envisaged the product with different amount of active substances based on their genders or activities. The claims are either anticipated because the limitations are clearly envisioned or obvious over the Holzl's teaching , or alternatively in view of conventionally known knowledge(see products(Right-Gard® or Speed Stic™ for man or Lady Speed stic ® soft & Dri™ for woman) available in market place.

One would have been motivated to do so, with reasonable expectation of success because it is always desirable to have extended therapeutic modalities to improve patient's compliance by enhancing patient satisfaction and increasing the selection option. The techniques and skills required for making such substitution is conventional knowledge or well within the skills of ordinary artisan as evidenced by OTC product and product information available in market place.

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One would have been motivated to combine these references and make the modification because they are drawn to same technical fields (constituted with same ingredients and share common utilities, and pertinent to the problem which applicant concerns about. MPEP 2141.01(a).

Conclusion

1. No claim is allowed.
2. US4170638 is particularly relevant because it teaches deodorant and it's activity of body odor reduction via antibacterial activity of odor inducing microorganisms (e.g. gram positive organisms such as *S. Aureus*, see abstract and col. 1).
3. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Vickie Kim whose telephone number is 571-272-0579. The examiner can normally be reached on Tuesday-Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Chris Low be reached on 571-272-0953. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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VICKIE KIM
PRIMARY EXAMINER

A handwritten signature in black ink, appearing to read 'Vickie Kim', is written over the printed name and title.

Vickie Kim
November 14, 2005
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